

REMARKS

The Office Action dated March 16, 2006, has been received and carefully noted. The above amendments and the following remarks are being submitted as a full and complete response thereto.

Entry of this Amendment is proper under 37 C.F.R. §1.116 since this Amendment: (a) places the application in condition for allowance for reasons discussed herein; (b) does not raise any new issue regarding further search and/or consideration since the Amendment amplifies issues previously discussed throughout prosecution; (c) does not present any additional claims without canceling a corresponding number of finally-rejected claims; and (d) places the application in better form for appeal, should an appeal be necessary. Entry of the Amendment is thus respectfully requested.

By this amendment, Claims 1 and 5 have been amended. Thus, Claims 1, 3, 5, and 7 are currently pending in the application and subject to examination. The Applicants submit the amendments to the claims are fully supported in the specification as originally filed, for example, at page 18, lines 14 to 22. Accordingly, the Applicants submit that no new matter has been added.

Rejection Under 35 U.S.C. § 102(e)

Claim 1 is rejected under 35 U.S.C. § 102(e) as being anticipated by Huang (U.S. Patent No. 6,777,819). To the extent this rejection applies to the claims currently pending, the Applicants respectfully traverse the rejection.

Claim 1, as amended, recites a surface-mounted electronic component module comprising a wiring substrate having wiring patterns formed on one side and external

connection terminals formed on the other side, the wiring patterns and the external connection terminals being connected with each other via holes or through holes, a plurality of electronic component devices mounted on the one side of the wiring substrate, at least one of the plurality of the electronic component devices being fastened face up to the one side of the wiring substrate and having a connection terminal, a bonding wire connecting the connection terminal of the one of the plurality of electronic component devices or with one of the wiring patterns formed on the one side of the wiring substrate, the bonding wire having a predetermined characteristic, yielding a specific inductance as an electric circuit element in connection with the one electronic component device, to which one terminal of the bonding wire is connected, and an exterior resin layer formed on the wiring substrate which covers the plurality of electronic component devices, and the bonding wire.

Applicants submit that the applied prior art fails to disclose or suggest all the elements of amended Claim 1. Specifically, Huang fails to teach or suggest, "the bonding wire having a predetermined characteristic, yielding a specific inductance as an electric circuit element in connection with the one electronic component device," as recited in amended Claim 1.

The Office Action cites the plurality of gold wires 23 disclosed in Huang as teaching this element, taking the position that "all electrical elements have a predetermined inductance," (see Office Action, page 2). However, the bonding wire of amended Claim 1 has a predetermined characteristic, which yields a specific inductance as an electric circuit element, in connection with one electronic device. Merely teaching a

plurality of gold wires, inherently having an inductance, fails to teach or suggest that the inductance is predetermined, and in particular, "the bonding wire having a predetermined characteristic, yielding a specific inductance as an electric circuit element in connection with the one electronic component device," as recited in Claim 1.

Further, in Claim 1, the bonding wire has a predetermined characteristic which yields a specific inductance as an electric circuit element in connection with one electronic component device. In Huang, the plurality of gold wires merely connects one electrical component device to another electrical component device, or to a connection terminal, and the plurality of gold wires merely has an inductance which is part of the inductance of the electric circuit as a whole.

To qualify as prior art under 35 U.S.C. § 102(b), a single reference must teach, i.e., identically describe, each feature of a rejected claim. For the reasons provided above, Applicants respectfully submit that Huang does not teach or suggest each and every feature recited by amended Claim 1. Accordingly, Claim 1 is not anticipated, nor rendered obvious in view of, Huang.

As such, Applicants respectfully submit independent claim 1 should be deemed allowable.

Rejection of Claim 3 Under 35 U.S.C. § 103(a)

Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Huang in view of Fujimoto et al. (U.S. Patent Application Publication No. 2001/0006456, hereinafter "Fujimoto"). The Applicants respectfully traverse the rejection.

Claim 3 depends directly from independent Claim 1. With respect to Claim 3, Fujimoto is applied in the rejection as teaching a component device attached face up to a substrate by a conductive paste. However, Applicants respectfully note that Fujimoto, alone or in any combination thereof, fails to teach or suggest at least "the bonding wire having a predetermined characteristic, yielding a specific inductance as an electric circuit element in connection with the one electronic component device," as recited in independent Claim 1. In other words, Fujimoto fails to overcome or otherwise address the deficiencies of the applied prior art with regards to Claim 3.

Accordingly, Applicants submit that Claim 3 is allowable over the applied prior art for at least the reasons set forth above with respect to Claim 1, as well as for the additional subject matter recited therein.

Rejection of Claims 5 and 7 Under 35 U.S.C. § 103(a)

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamada et al. (U.S. Patent No. 6,784,765, hereinafter "Yamada") in view of Huang. Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamada et al. (U.S. Patent No. 6,784,765, hereinafter "Yamada") in view of Huang and further in view of Fujimoto. To the extent these rejections remain applicable to the claims currently pending, the Applicants respectfully traverse the rejections.

Claim 5 recites a surface-mounted electronic component module comprising, among other features, a bonding wire having one terminal connected to the surface acoustic wave filter and the other terminal connected to the connection terminal of the semiconductor chip, the bonding wire having a predetermined characteristic, yielding a

specific inductance as an electric circuit element to improve a frequency band characteristic of the surface acoustic wave filter.

The Applicants submit that the applied prior art fails to teach or suggest all the elements of amended Claim 5. Specifically, the applied prior art fails to disclose or suggest at least “the bonding wire having a predetermined characteristic, yielding a specific inductance as an electric circuit element to improve a frequency band characteristic of the surface acoustic wave filter,” as recited in Claim 5.

The Office Action admits that Yamada fails to disclose or suggest at least this element. Huang is cited as curing this deficiency. However, as discussed above, Huang fails to disclose or suggest at least “the bonding wire having a predetermined characteristic, yielding a specific inductance as an electric circuit element to improve a frequency band characteristic of the surface acoustic wave filter.”

Therefore, the Applicants submit that Yamada and Huang, alone or in any combination, fail to teach or suggest all the elements recited in amended Claim 5.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. § 2143.03. For at least the reasons provided above, Applicants submit that Yamada in view of Huang, either alone or in combination, do not teach or suggest all the elements of amended Claim 5.

Claim 7 depends from independent Claim 5. With respect to Claim 7, Fujimoto is applied in the rejection as teaching a component device attached face up to a substrate by a conductive paste. However, Applicants respectfully note that Fujimoto, alone or in any combination thereof, fails to teach or suggest at least “the bonding wire having a

predetermined characteristic, yielding a specific inductance as an electric circuit element to improve a frequency band characteristic of the surface acoustic wave filter,” as recited in independent Claim 5. In other words, Fujimoto fails to overcome or otherwise address the deficiencies of the applied prior art with regards to Claim 7.

Accordingly, Applicants submit that Claim 7 is allowable over the applied prior art for at least the reasons set forth above with respect to Claim 5, as well as for the additional subject matter recited therein.

Further, under U.S. patent practice, the U.S. Patent and Trademark Office has the burden under 35 U.S.C. §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the U.S. Patent and Trademark Office itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under 35 U.S.C. §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The U.S. Patent and Trademark Office can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

The Office Action restates the advantages of the present invention to justify the combination of references. There is, however, nothing in the applied references to evidence the desirability of these advantages in the disclosed structure. Thus, the Applicant submits that a *prima facie* case of obviousness has not been established.

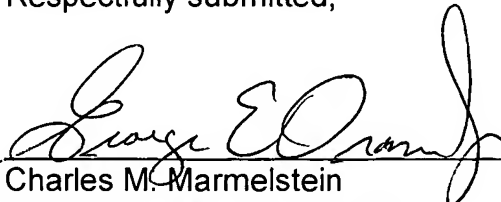
Conclusion

In view of the foregoing, reconsideration of the application, withdrawal of the outstanding rejections, allowance of Claims 1, 3, 5, and 7, and the prompt issuance of a Notice of Allowability are respectfully solicited.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event that this paper is not being timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to Counsel's Deposit Account Number 01-2300, referencing Docket Number 108066-00087.

Respectfully submitted,


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